

REMARKS**Status of the Claims**

Upon entry of the amendment above, claims 1-35 will be pending, claims 1, 8, 13, 19, 21, and 34 being independent.

Summary of the Office Action

As indicated on the cover page, the Examiner has acknowledged the priority claim and receipt of the certified copy of the priority application.

As evidenced by the Examiner-initialled PTO-1449 form, the Examiner has acknowledged his consideration of the U.S. patents cited by Applicants in their previously filed information disclosure statement. However, the Examiner has not indicated his consideration of two French language documents cited in the information disclosure statement.

The drawings are objected to under 37 CFR §1.84(p)(5) for including reference numeral 5 which is not mentioned in the description.

Claims 1-4 and 6-10 are rejected under 35 USC §102(b) as being anticipated by KOGERT et al. (U.S. Patent No. 3,570,149, hereinafter "KOGERT").

Claim 5 is rejected under 35 USC §103(a) as being unpatentable over KOGERT in view of DONZIS (U.S. Patent No. 5,232,715).

Claims 11 and 12 are rejected under 35 USC §102(b) as being unpatentable over KOGERT in view of NORTON et al. (U.S. Patent No. 6,558,784, hereinafter "NORTON").

Response to the Office Action**A. Summary of Amendment**

In the amendment above, Applicants have changed the title of the invention to be consistent with the preambles of the claims.

The specification has likewise been amended for that reason and for improving the thereof.

In addition, the original claims have been amended to improve their form and to add, in independent claims 1 and 8, that *less than the entirety of the upper is coated with a liquid polymer*. In addition, new claims 13-35 have been added.

No prohibited new matter has been added by way of amendment.

B. Consideration of French Documents in Applicants' Previously Filed Information Disclosure Statement

In the photocopy of the PTO-1449 form that Applicants had included with their information disclosure statement filed on March 21, 2002, which was attached to the Office action to which Applicants now respond, the Examiner has crossed-through the listing of two French patent documents (as well as his initials adjacent the listings).

In addition, in Section 1, at the top of page 2 of the Office action, the Examiner explains that Applicants' information disclosure statement failed to comply with the requirements of 37 CFR §1.98(a)(3) because it allegedly does not include a concise explanation of the relevance of each listed patent that is not in the English language. As a result, the Examiner explains that the information disclosure statement has been placed in the file, but "with respect to the foreign references," it has not been considered.

Applicants disagree with the Examiner's interpretation of the requirement of 37 CFR §1.98(a)(3) that led to his refusal to consider the two foreign documents, viz., FR 598 761 and FR 726 292. In fact, Applicants submit that their information disclosure statement is in compliance with §1.98(a)(3) and is in compliance with the guidelines provided for in the Manual of Patent Examining Procedure, Section 609 (page 600-122, 8th Ed. August 2001, Rev. February 2003).

In MPEP §609, it is explained that:

Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report.

Consistent with the above-quoted guideline, Applicants' information disclosure statement filed on March 21, 2002 included a copy of the search report for their French priority application (No. 00.17127). Because the search report is not in the English language, Applicants included the following comment on page 1 of their search report: "For compliance with the "concise explanation" requirement set forth in 37 CFR 1.98(a)(3), consistent with U.S. Patent and Trademark Office policy, Applicants describe below any comments relating to pertinent portions of the respective documents, where such comments appear in the search report."

Further, and again consistent with the aforementioned guidelines, Applicants included the following information, in English, in their information disclosure statement regarding the two French documents, which information was taken directly from the search report:

French Patent No. 598,761 (DESPREZ), published on December 24, 1925, is cited as being a document that is pertinent to the general state of the art (i.e., a category "A" document) with regard to the invention recited in claim 1 of Applicants' aforementioned priority application. Page 2, lines 14-26, and the figures of FR '761 are cited as being pertinent.

French Patent No. 726,292 (LENTZ), published on May 26, 1932, is cited as being a document that is pertinent to the general state of the art (i.e., a category "A" document) with regard

to the invention recited in claim 1 of Applicants' aforementioned priority application. The entirety of FR '292 is cited as being pertinent.

In view of the foregoing, *i.e.*, in view of the fact that Applicants' previously filed information disclosure statement complies with 37 CFR §1.98(a)(3) and the guidelines therefor set forth in MPEP §609, consideration of the aforementioned two French documents is requested.

For this purpose, a PTO-1449 is attached which lists the French documents. Another copy of the aforementioned search report is also attached. The Examiner is requested to consider the documents and to confirm such consideration by appropriately initialling the listings on the PTO-1449 form and returning a copy of the initialled form to Applicants.

C. Withdrawal of Objection to the Drawings

Applicants request that the objection to the drawings under 37 CFR §1.84(p)(5) be withdrawn in view of Applicants' amendment to paragraph 0016 of the specification, above. Therein, Applicants have added the sentence "The illustrated embodiment includes a lacing 5 for tightening the upper upon the foot."

Applicants submit that the lacing was clearly shown in the original drawings and it is readily apparent that reference numeral "5" is directed to the lacing. Accordingly, the specification, as amended, includes a reference to numeral "5". Therefore, withdrawal of the objection to the drawing under §1.84(p)(5) is requested.

D. Summary of Interview and Request for Withdrawal of Rejections Under 35 USC §§102, 103

At least for the following reasons, Applicants request that the rejections based upon KOGERT, solely or primarily, whether for anticipation or for obviousness, be withdrawn.

As Applicants' undersigned representative mentioned during an interview with the Examiner on October 16, 2003, the *entirety* of the shoe of KOGERT is coated. In column 1, lines 54-58, KOGERT explains: "[i]n accordance with the invention, ... the whole shoe [is] coated with a cohesive polyurethane layer" As mentioned in column 2, lines 25-30 of KOGERT, the coating is preferably done by injection molding.

By contrast, according to one objective of Applicants' invention, as explained in paragraphs 0006-0010 of the specification, it is desirable to ensure good ventilation of the foot for certain sporting activities (using a mesh material, for example), while providing, at the same time, a certain resistance to wear, such as resistance to abrasion.

Therefore, according to particular embodiment(s), only portion(s) of the upper and, perhaps, portion(s) of the sole are coated with a liquid polymer. In this regard, independent claims 1, 8, 13, and 21 specify that a polymer layer is, or has been applied to, less than the entirety of the upper of the article of footwear of the invention.

Applicants also direct attention to certain of their claims which additionally call for the polymer layer to be applied to the sole or at least a portion of the sole of the article of footwear of the invention. See, *e.g.*, dependent claims 4, 9, 18, and 26.

Also, as also mentioned during the aforementioned interview, and as mentioned in paragraph 0011 of the specification of the instant application, another feature of the invention lies in having a polymer coating, but avoiding the effect one would achieve of the shoe/boot were to be immersed in a latex bath, *e.g.*, of having the coating create a straight line demarcating the coating and the remainder of the upper. Accordingly, in independent claims 19 and 34 (directed to a method and an apparatus, respectively), Applicants call for "a polymer layer having an upper edge extending along a line varying in height along a length of said upper"

and "said layer of polymer having an upper edge extending along a line varying in height along a length of said upper," respectively. See also dependent claims 16 and 24. Further, claims 17, 20, 25, and 35, which depend from claims 16, 19, 24, and 34, respectively, call for the line of the upper edge of the polymer coat to rise in height along a rear of the upper (as shown in Figs. 1 and 3).

In addition to the invention differing from the disclosure of KOGERT at least for the foregoing reasons, Applicants submit that it would not have been obvious to have modified KOGERT in a way that would have resulted in Applicants' invention. Neither of the secondary documents, DONZIS and NORTON include teachings or suggestions for curing the deficiencies of KOGERT relating to the foregoing.

Regarding DONZIS and the rejection of dependent claim 5, Applicants do wish to point out the following, however. Method claim 5 includes a further limitation of the invention specified in parent claim 1 which calls for "diluting the polymer in a solvent." DONZIS' disclosure is directed to forming the outer wall of an impact absorber; not to applying a coating on an article of footwear. More to the point of claim 5, however, is that a solution of a prepolymer, mentioned by DONZIS, is not a diluted polymer, but it is the product before polymerization has taken place.

Regarding NORTON and the rejection of dependent claims 11 and 12, Applicants note that NORTON does not disclose a three-dimensional mesh fabric.

In addition to Applicants' dependent claim 12 calling for the upper to include a three-dimensional mesh material, attention is directed to newly added claims 14, 15, 22, and 23, which describe the three-dimensional mesh in greater detail, which is schematically shown in Fig. 4.

SUMMARY AND CONCLUSION

The grounds of objection and rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

A check is enclosed for payment of a claim fee. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Further, although an extension of time for a single month is believed to be necessary at this time, if it were to be found that an extension of time for additional month(s) were to be necessary to render this reply timely and/or complete, Applicants request an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) that, in such event, would render this reply timely and/or complete, and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,
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Attachments: PTO-1449 form
Search Report from priority application